PRE-APPEAL BRIEF REQUEST FOR REVIEW (filed with the Notice of Appeal)	Docket Number 042933/299170
Application Number 09/936,557	Filed January 2, 2002
First Named Inventor Christian Kraft	
Art Unit 2174	Examiner Ke, Peng

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

Respectfully submitted,

Cory C. Davis

Cory C. Davis
Registration No. 59,932

Date November 26, 2007

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street,
Suite 4000
Charlotte, NC 28280-4000
Tel Atlanta Office (404) 881-7000
Fax Atlanta Office (404) 881-7777

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Attachment
Reasons for Requesting Pre-Appeal Brief Request for Review

I. Claims 15, 29, 39, 40, 43, 45, 46, 49 & 51 are not obvious

Claims 15, 29, 39, 40, 43, 45, 46, 49 and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Deluca et al. (International Publn. No. WO 97/19429) in view of Mochizuki (U.S. Patent No. (USP) 6,044,248") further in view of Miller (USP 6,421,707). Claim 15 requires, *inter alia*, "generating *a compound message including* a *text part* and at least one *graphical icon part*, ... adding *a graphical part* to the message, ... the at least one graphical icon part in a graphical format, ... the ... *graphical icon part in the text part*; and *transmitting of the message* via the wireless network."

On pg. 15 of the Final Office Action, the Examiner continues to rely on pg. 5, lines 13-14 of Deluca as disclosing generating a compound message including a text part and at least one graphical icon part. Applicant disagrees and submits that the Examiner is giving the combination of references credit for more than what they actually teach. Deluca, in contrast to claim 15, at best, discloses messages that are transmitted to a receiving device 100 in which a numerical code is utilized to identify an icon, prestored by the receiving device), with the code being selected by the message composer at a transmitting device 305. Upon receipt, the receiving device uses the numerical code to identify and retrieve the graphical icon from a memory of the receiving device, thereby eliminating a need to transmit any information to the receiving device beyond the numerical code to cause the display of the encoded icon. Deluca does not disclose any transmitted message which contains a graphical part, but rather, discloses that a transmitted message contains only text, e.g., code "#07". Page 5, lines 13-14 of Deluca, describes a message containing only text, "for example, alphanumeric characters" and discusses that the "[r]eception of a display command for a message comprising the characters of "#07TOM?" results in subsequent presentation of the image associated with the code "#07" at display 130. Receiver 100 recognizes alphanumeric code "#07" in the message and retrieves corresponding image data, i.e., coffee mug based on the code, which is previously stored in a graphics database 155 of the receiver 100.

In view of the foregoing, Deluca, at best, discloses that any graphical part corresponding to the transmitted numerical code is retrieved from a memory (i.e., graphics database) and displayed after the message is received at the device 100. Deluca discloses only messages that include either (1) a numerical code, e.g., "#07" (pg. 5); (2) a numerical code and any desired additional text to be

displayed at the receiving device, e.g., "TOM?#07" (pg. 5); or (3) a numerical code and any desired additional numerals to be displayed at the receiving device, e.g., "#073331111" (pg. 5). Deluca discloses that the numerical code uses "predetermined characters ... found on conventional telephone receivers." (pg. 3, lines 30-31) A skilled artisan clearly understands that "text" generally includes letters, numerals, and symbols (e.g., "#" and "*") and as such, a skilled artisan would consider the messages of Deluca to include only text. In view of the foregoing, the messages taught by Deluca include only text and do not include a graphical icon part, as claimed. As such, the combination of Deluca, Mochizuki and Miller does not teach or suggest "generating a *compound message* including *a text part* and at least one *graphical icon part* ... and "transmitting of the [compound] *message* via a wireless network," as required by claim 15. On pg. 2 of the Advisory Action, the Examiner asserts that "features upon which "[A]pplicant relies (i.e., the actual transmitting of the graphic icon are not recited in the rejected claim(s)." Applicant disagrees. Claim 15 clearly recites "*a compound message including* a *text part* and at least *one graphical icon part* ... and transmitting ... *the message*," which "*includ[es] the text part and* the at least *one graphical icon part,*" "via the wireless network." As such, claim 15 is patentable at least for the reasons above which were also previously of record.

The Examiner continues to rely on Mochizuki to make up for the deficiencies of Deluca. Applicant disagrees. Similar to Deluca, Mochizuki discloses a call receiver which receives a transmitted message that includes a "graphic image code." Mochizuki explains that the graphic image code is a numeric code corresponding to a predefined illustration residing in the receiving device. The receiver of Mochizuki includes a code memory storing graphic image units and graphic image unit codes. Mochizuki discusses that code information is extracted from a message. The code information includes a graphic image unit code and a character data code. "Based on the code information, a graphic image unit corresponding to the graphic image unit code and a piece of character data ... are read from the code memory" 108 "and then the message with the graphic image unit and the piece of character data is displayed." (Col. 2, lines 1-10)

FIGS. 4A and 4B of Mochizuki show that the graphic image codes are alphanumeric codes. Nowhere in Mochizuki is there any teaching or suggestion that the graphic image codes are graphic images or graphic image parts. For instance, col. 6, lines 57-67 of Mochizuki describes that the processor 104 asks the user whether to input a desired graphic image code in

the transmission message. As such, the processor stores the selected graphic image code (GIC) (See "01," - "08" in FIGS. 4A & 4B) in the transmission message. In view of the foregoing, Mochizuki, alone or in combination with Deluca and Miller, fails to teach or suggest generation of "a compound message *including* a text part *and at least one graphical icon part*," "and transmitting ... the message via the ... network," as required by claim 15. Additionally, the combination fails to teach or suggest "adding a graphical part *to the message*, the ... graphical icon part *in a graphical format*, ... the ... graphical icon part *in the text part*, as required by claim 15. On pg. 2 of the Advisory Action, the Examiner posits that Mochizuki discloses "transmitting of the message via the wireless network" allegedly because the "same message constructed on the sender side ... is transmitted to the receiver ... through a wireless network." Even assuming *arguendo* that Mochizuki discloses that a message is transmitted through a wireless network, Mochizuki, like Deluca, does not teach or suggest "generating *a compound message* including *a text part* and at least *one graphical icon part* ... adding a graphical part to *the message* ... and transmitting *the* [compound] *message* via the ... network," as claimed.

The Examiner relies on Miller as disclosing a "graphical icon part [that is] in a graphical format." Applicant disagrees. According to Miller, a multimedia message and multimedia attachments may be received by a network and delivered to a device 411 of a subscriber. Miller, at best, discloses that the multimedia attachments may consist of text, speech, fax, image, [and] video" data. (Col. 1, lines 34-62) Miller describes that the multimedia messages may be a plain text file 404, a common graphics file 405 (e.g., "Power-Point") and sound file 406 in .wav format. (Col. 4, lines 29-35)

Col. 4, lines 26-35 of Miller describes that when a subscriber (e.g., Radhika) sends an e-mail with multimedia attachments to another subscriber (e.g., Thomas) the "attachments 404, 405 and 406 [are] in the upper panel" of an internet browser screen and are not within the text of the message "shown in the scrollable text window 403." As shown in FIGS. 4(h) & 4(i) of Miller, the text message received from a subscriber, such as Radhika, at device 411 is separate and distinct from the graphics file attachment 406 such as the Power-Point attachment. FIG. 4(i) clearly shows that the graphics file attachment 405 (i.e., "4:PowerPoint (64K)") is not within the text message 404 shown in FIG 4(h) (i.e., "Hello Thomas, I am enclosing a copy of a recent luc"), as required by claim 15. As such, Miller (alone or in combination with Deluca and Mochizuki) does not teach or

suggest "at least one graphical *icon part* [that is] in a *graphical* format ... "the ... graphical icon part *in the text part*," as required by claim 15. In view of the foregoing, Applicant submits that the combination of Deluca, Mochizuki and Miller are deficient and does not teach or suggest all of the features of claim 15 and requests reversal of the § 103(a) rejection of claim 15 and its dependent claims 40, 46 and 52.

Since claims 29 and 39 contain features that are analogous to, though not necessarily coextensive with, the features recited in claim 15, Applicant submits that claims 29 and 39 as well as their respective dependent claims 43, 49, 55 and 45, 51, 57 are patentable at least for reasons analogous to those submitted for claim 15.

II. Claims 52, 55 and 57 are not obvious

Claims 52, 55 and 57 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Deluca, Mochizuki, Miller and in view of USP 6,032,025 to Sugio et al. Applicant disagrees. As discussed above, Deluca, Mochizuki and Miller (alone or in combination) are deficient vis-à-vis independent claims 15, 29 and 39. Sugio does not make up for the deficiencies of Deluca, Mochizuki and Miller (alone or in combination). Accordingly, claims 52, 55 and 57 are patentable at least by virtue of their respective dependencies from claims 15, 29 and 39.

III. Claims 16, 19-25, 30, 33-38, 41, 42, 44, 47, 48, 50, 53, 54 & 56 are not obvious

Claims 16, 19-25, 30, 33-38, 41, 42, 44, 47, 48, 50, 53, 54 and 56 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sugio, Mochizuki and in view of Miller. Claim 16 requires, *inter alia*, "a ... application ... to "*generate a compound message* including *a text part* and at least *one graphical icon part* ... the controller generates the *compound message for being transmitted* via the transceiver including a text part ... *a graphical part ... graphical icon part* in a *graphical format*, and ... the ... *graphical icon part in the text part.*"

Applicant submits that the combination of Sugio, Mochizuki and Miller does not teach or suggest at least the above features of claim 16. Rather, Sugio, at best, discloses the display of a message, including a portrait image, on a pager 4. Similar to Deluca and Mochizuki, the portrait image ultimately displayed on the receiving device of Sugio is not contained in the message that is transmitted to the receiving device. Rather, the transmitted message contains an alphanumeric "image designating code," (e.g., "portrait codes" "21" to "36" (FIG. 4)) which is analogous to the numerical code of Deluca and Mochizuki. This image designating code of Sugio causes the

pager 4 to retrieve from memory (e.g. ROM 19) and display a portrait image corresponding to the received image designating code. Sugio, discloses that the message may include "characters, numerals, and symbols," e.g., "*5*528," which causes a predefined portrait to be displayed on the pager 4. (Col. 9, lines 24-34).

Additionally, FIGS. 36A-36E of Sugio, indicate that only the image designating code (containing only numerals and symbols), and not the actual image itself, is transmitted. Based on the foregoing, Applicant submits that Sugio does not teach or suggest any message that includes a graphical icon part. And there certainly is no disclosure relating to any graphical icon part that is in the text part. As such, the combination of Sugio, Mochizuki and Miller fails to teach or suggest "a *compound* message *including a text part and at least one graphical icon part*, ... controller generates *the compound message* ... *transmitted* via the transceiver ... including a text part ... a graphical part ... the ... graphical icon part in a graphical format ... the at least one *graphical icon part in the text part*," as required by claim 16. As noted above with respect to claim 15, Mochizuki and Miller, alone or in combination, do not teach or suggest these features either and as such do not make up for the deficiencies of Sugio. Based on at least the foregoing, Applicant submits that the combination of Sugio, Mochizuki and Miller are deficient and does not teach or suggest all of the features of claim 16 and requests reversal of the § 103(a) rejection of claim 16 and its dependent claims 17-24, 26-28, 41, 47 and 53.

Since claims 25 and 30 contain features that are analogous to, though not necessarily coextensive with the features recited in claim 16, Applicant submits that claims 25 and 30 as well as their respective dependent claims 42, 48, 54 and 31-38, 44, 50 and 56 are patentable at least for reasons analogous to those submitted for claim 16.

IV. Claims 17, 18, 26, 27, 28, 31 and 32 are not obvious

Claims 17, 18, 26, 27, 28, 31 and 32 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sugio, Mochizuki, Miller in view of U.S. Patent No. 6,047,828 to Medina. Applicant disagrees. As discussed above, Sugio, Mochizuki and Miller are deficient vis-à-vis independent claims 16, and 30. Medina does not make up for the deficiencies of Sugio, Mochizuki and Miller. As such, claims 17, 18, 26, 27, 28, 31 and 32 are patentable at least by virtue of their respective dependencies from claims 16 and 30.

Accordingly, for all the reasons discussed above, Applicant respectfully requests that the § 103(a) rejections of claims 15-57 be reversed.